

REMARKS

Claim Rejections under 35 U.S.C. § 103.

An invention is unpatentable under 35 U.S.C. § 103(a) ("Section 103") "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

To establish a *prima facie* case of obviousness, three criteria must be met. "First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2142.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Indeed, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." MPEP § 2142.

A "clear and particular" showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.* For the reasons set forth below, Applicant submits that the prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicant's claims are not obvious in view of the prior art references.

Claims 1, 6-8, 11-12, 22 and 27 stand rejected under Section 103 as obvious in view of U.S. Pat. No. 5,945,092 to Krog (“Krog”) in combination with WO 01/15537 to Wadsworth (“Wadsworth”). Claims 1 and 6 also stand rejected under Section 103 as unpatentable over Wadsworth in view of U.S. Pat. No. 5,288,491 to Moniz (“Moniz”). Claims 1, 6-8, 11-12, 22 and 27 also stand rejected under Section 103 as obvious in view of U.S. Pat. No. 6,261,566 to Pillai (“Pillai”), Wadsworth and Moniz.

Applicant respectfully submits that the above-referenced art, considered cumulatively, does not render the present invention obvious for the reasons set forth below.

Specifically, Applicant has amended independent claim 1 to recite a lip treatment comprising Morinda citrifolia seed oil as well as “Morinda citrifolia fruit juice present in an amount between about 0.1-50 percent by weight.” This amendment adds no new matter as it finds adequate support in the specification as filed. See Specification, p. 13. Applicant finds no mention of this claim limitation in any cited reference, nor any equivalent thereof.

Indeed, Krog discloses an anhydrous cosmetic stick composition comprising, among other components, 1-20% of a cosmetically acceptable essential oil. Krog fails to mention or suggest Morinda citrifolia fruit juice as a possible beneficial component of the disclosed invention.

Wadsworth teaches a process of extracting and purifying Morinda citrifolia oil from the seeds of the Morinda citrifolia plant. Wadsworth also fails to disclose or suggest use of Morinda citrifolia fruit juice for any purpose.

Moniz discloses a method for processing the Morinda citrifolia plant into powder. Although Moniz discloses that Morinda citrifolia fruit juice may be ingested by a patient to treat certain systemic disorders, Moniz neither discloses nor suggests topical application of a Morinda citrifolia fruit juice-containing compound, as disclosed by the present application. Indeed,

Moniz teaches away from topical application of a *Morinda citrifolia* fruit juice-containing compound as Moniz emphasizes that the benefits of noni juice may only be realized upon activation of the “appreciable amounts of the precursor of xeronine” present in the juice. Moniz notes that the best chance of noni juice becoming activated is if the juice is taken on an empty stomach. See col. 3, ln. 12-17. Moniz would thus likely discourage one skilled in the art from applying noni juice topically.

Pillai, on the other hand, is entirely directed to cosmetic skin care compositions for topical application. Pillai, however, specifically teaches cosmetic use of “a glycolic extract from the root of white mulberry,” otherwise known as *Morus Alba*. See col. 2, ln. 27-29. Pillai neither discloses nor suggests use or substitution of *Morinda citrifolia* juice, or a derivative thereof, for or in addition to the mulberry extract of the claimed composition.

The differences between *Morus alba* and *Morinda citrifolia* are numerous and substantial. For example, *Morus alba* and *Morinda citrifolia* are classified in separate and distinct plant families. *Morus alba* belongs to the Moraceae family, while *Morinda citrifolia* belongs to the Rubiaceae family. Characteristics common to the Moraceae family include leaves that are simple, alternate, and rarely opposite, and flowers that are unisexual and minute. The Rubiceae family, on the other hand, features leaves that are simple and usually entire, and are opposite or whorled. Also, Rubiceae flowers are nearly always bisexual. See <http://www.botany.hawaii.edu/faculty/carr.html>. (visited August 14, 2002).

Based on the divergent classifications and characteristics of the *Morus alba* and *Morinda citrifolia* plants, it is unlikely that one skilled in the art would consider such plants interchangeable or likely to induce similar effects. In addition, Pillai relies on the combined effect of *Morus alba* specifically and selected retinoids, thus the Pillai disclosure is limited to a

composition that specifically includes Morus alba. Since Pillai fails to suggest, and in fact teaches away from, the use or substitution of Morinda citrifolia, or any derivative thereof, for or in addition to the Morus alba of the claimed composition, the present invention is not rendered obvious in view of Pillai under Section 103.

Applicant respectfully submits that the inability of the combined references to produce Applicant's invention and the lack of any suggestion or motivation to modify such art to produce Applicant's invention renders the present invention non-obvious in view of such references.

Claims 6-8, 11-12, 22 and 27 are not rendered obvious by the cited references as each adds further limitations to otherwise allowable subject matter. Applicant thus respectfully requests withdrawal of the rejections of claims 1, 6-8, 11-12, 22 and 27 under Section 103.

Conclusion

Based on the foregoing, Applicant believes that the claims of the present invention are in condition for allowance and respectfully requests the same.

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to initiate a telephone interview with undersigned counsel.

DATED this 31 day of October, 2002.

Respectfully submitted,

Michael R. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

AVV

650302.1

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

1. (Amended) A lip treatment comprising:

Morinda citrifolia seed oil present in an amount between about 0.1-20 percent by weight;

Morinda citrifolia fruit juice present in an amount between about 0.1-50 percent by weight;

and at least one of:

(i) linoleic acid; and

(ii) xeronine.

6. (Cancel)